

## REMARKS

In the Office Action dated March 12, 2003, claims 1-37 were pending. Claims 1-37 were rejected under 35 U.S.C. 102(b) and 103(a).

In this response, no claim has been cancelled and claims 1 and 15 have been amended to particularly point out and distinctly claim, in full, clear, concise, and exact terms, the subject matter which Applicant regards as his invention. Thus, claims 1-37 remain pending. Applicant submits that no new matter has been added. Reconsideration of this application is respectfully requested.

### Rejections Under 35 U.S.C. §102

Claims 1-2 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Collins et al. (U.S. Patent No. 4,550,058).

To anticipate a claim, the reference must teach every element of the claim. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (Manual of Patent Examining Procedures (MPEP) 2131.)

Applicant respectfully submits that claims 1-37 include the limitations that are not disclosed or claimed by Collins. In particular, independent claim 1 includes limitations of a rubber layer molded onto at least a part of a plastic piece over a protective barrier, where the protective barrier prevents the rubber layer from disrupting a structure of the plastic piece. Applicant submits that Collins fails to disclose such limitations.

Rather, as the Examiner admitted, Collins discloses a structure including a polycarbonate rod wrapped by an intermediate layer and an outer layer of soft plasticized

polyvinyl chloride (col. 6, lines 36-50). The Examiner contends that the “soft plasticized polyvinyl chlorate” constitutes a rubber. Applicant respectfully disagrees. Rubber, particularly natural rubber is obtained from the milky secretion (latex) of various plants or trees, while a plastic is a product made from oil and polyvinyl chloride (PVC) is a member of vinyl plastics, a group of thermoplastics used in molded products with heat and pressure, according to the Encyclopedia, available from [www.encyclopedia.com](http://www.encyclopedia.com). A plastic is made up principally of a binder together with plasticizers, fillers, pigments, and other additives. However, rubber and plastic (particularly PVC) are different materials obtained from significantly different sources. Applicant submits that Collins fails to disclose or suggest using rubber.

The Examiner further contends that Collins discloses the soft layer (e.g., alleged “soft plasticized PVC) can include a “rubber modified styrene resin”, which allegedly reads on independent claim 1 of the present application. However, Applicant submits that even the rubber modified styrene resin cannot constitute a rubber, it can only achieve a rubberlike appearance. It is typically used to combine with plastic to make the plastic softer.

In addition, as described in the specification of the present invention, rubber normally cannot be combined with plastic because the rubber would attack the plastic and cause structural damages to the plastic. The fact that Collins discloses using rubberlike materials, instead of rubber, further suggests such combination (e.g., a combination of rubber and plastic) would not be practically achieved at the time. Applicant respectfully submits that Collins teaches away from, rather than towards to, the present invention as claimed, and one with ordinary skill in the art, based on the teachings of Collins, would not be able to conceive the present invention as claimed. Therefore, for reasons discussed above, independent claim 1 is not anticipated by and is patentable over Collins.

Similarly, independent claim 15 includes limitations similar to those claimed in claim 1. Therefore, for reasons similar to those discussed above, independent claim 15 is not anticipated by and is patentable over Collins.

The rest of the claims depend from one of the above independent claims, thus include all of the distinct features of the respective independent claim, and therefore, for the reasons similar to those discussed above, are not anticipated by and are patentable over Collins.

#### Rejections Under 35 U.S.C. §103(a)

Claims 1-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Collins in view of Horn et al. (U.S. Patent No. 5,326,800), Nilsen et al. (U.S. Patent No. 6,258,443), Giles et al. (U.S. Patent No. 4,543,291), Zabrocki et al. (U.S. Patent No. 5,334,450), Hull et al. (U.S. Patent No. 3,496,000), Adur et al. (U.S. Patent No. 6,007,902), Grimm et al. (U.S. Patent No. 5,856,371), Perry et al. (U.S. Patent No. 6,221,436)

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). (Manual of Patent Examining Procedure (MPEP) ¶ 2143.03).

Applicant submits that claims 1-37 of the present application include limitations not disclosed or taught by the cited references. As a result, claims 1-37 are patentable over the cited references.

Particularly, none of the cited references, individually or in combination, discloses or suggests using rubber with a protective barrier as discussed above with respect to independent claims 1 and 15. These cited references do not suggest combining with one another. Even if these cited references were combined, such a combination still lacks the limitations claimed in

independent claims 1 and 15. Therefore, for at least the reasons similar to those discussed above, Applicant submits that independent claims 1 and 15 are patentable over the cited references.

In addition, as claimed in claims 9 and 28, the structure having rubber and plastic with a protective barrier may be formed under ambient conditions, particularly under conditions similar to those claimed in claims 29-32 and 35-36. The above limitations are not disclosed by any of the cited references. Instead, the Examiner relies heavily on the assertions that it would have been obvious to one having ordinary skill in the art at the time of invention to suggest such limitations without producing the corresponding support references (see, the Office Action, page 15, second paragraph). It appears that the Examiner's assertions are based on Applicant's own disclosure. Therefore, in addition to those applied to their respective independent claims, for reasons discussed above, claims 9, 28-32, and 35-36 are independently patentable over the cited references.

Furthermore, as claimed in claims 25-27, the protective barrier layer is formed via a liquid solution comprising an isocyanate component and a polyol component, which are also absent from the cited references, individually or in combination. Therefore, in addition to those applied to their respective independent claims, for reasons discussed above, claims 25-27 are independently patentable over the cited references.

The rest of the claims depend from one of the above independent claims, thus include all of the distinct features of the respective independent claim, and therefore, for the reasons similar to those discussed above, are patentable over the cited references.

CONCLUSION


In view of the foregoing, Applicant respectfully submits the present application is now in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call the undersigned attorney at (408) 720-8300.

Please charge Deposit Account No. 02-2666 for any shortage of fees in connection with this response.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

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